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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,295	03/03/2004	Yoshinobu Suehiro	PTGF-03109	3532

21254 7590 09/29/2006

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EXAMINER

ARENA, ANDREW OWENS

ART UNIT	PAPER NUMBER
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2811

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/791,295

Applicant(s)

SUEHIRO ET AL.

Examiner

Andrew O. Arena

Art Unit

2811

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

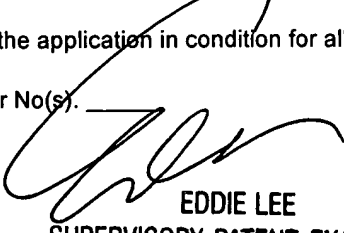
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: n/a.
Claim(s) objected to: n/a.
Claim(s) rejected: 1-11 and 26-37.
Claim(s) withdrawn from consideration: n/a.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____


EDDIE LEE
SUPERVISORY PATENT EXAMINER
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Continuation of 11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because: Applicant's arguments are premised primarily on distinctions between the methods by which the prior art and applicant's claimed structures are made, supplemented by allegations that examiner's combinations are non-obvious. Neither premise is persuasive.

The independent claims have been amended to recite the "light emitting element [is] inserted into said [recess]". Juestel and Lowery are the only references relied upon for this feature, and both references disclose an LED in a recess (Juestel Drawing 1, Lowery Fig 4). The appropriate interpretation of a "light emitting element [is] INSERTED into said [recess]" is simply an "LED is IN said [recess]". This interpretation is supported by at least four significant factors, as follows.

- 1) In the reply filed 09/20/2006, applicant directed attention (pg 6) to the present application at Fig 5B and pg 12 ln 26-28 as supporting the claimed recitation, both of which merely describe an LED in a recess, not a process by which an LED is inserted into a recess.
- 2) It is not clear to the examiner that such a process is even supported by the original disclosure, but even if it were, limitations from the specification are not read into the claims. See MPEP 2145(VI).
- 3) Applicant's arguments can overcome the references only if said recitation was regarded as a method step. However, the patentability of a product does not depend on its method of production. See MPEP 2113.
- 4) Regarding said method step, examiner notes that the method was non-elected without traverse in the reply filed 11/23/2005.

Applicant alleges the references are "unrelated" by selecting and comparing certain limiting portions of the disclosures as if said portions defined the field of endeavor of their respective references. Examiner submits that the field of endeavor of applicants invention and every single cited reference is packaging light emitting diodes.

Applicant alleges "the references provide no motivation or suggestion to urge the combination as alleged by the examiner" but supports said allegations only with assertions that the references are unrelated. As shown above, all references are closely related. Examiner has established a prima facie case of obviousness and provided proper motivations, see MPEP 2143.01 and 2144; applicant has burden to rebut, see MPEP 2142. Attorney arguments are not the kind of factual evidence that is required to rebut, see MPEP 2145(I).

Applicant's arguments are not deemed to overcome the references as applied by the examiner.
All claims remain rejected as in the Office Action dated 07/20/2006.